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<u>11/06/2007</u>	<u>/Pamela Gerik/</u>
Date	Pamela Gerik

**REQUEST FOR PRE-APPEAL BRIEF REVIEW**

Dear Sir/Madam:

This paper is submitted in conjunction with a Notice of Appeal for the rejections of claims 1-9 and 24-27 in response to the Advisory Action mailed September 25, 2007 for the captioned case. The Appellant respectfully requests a review of the presented arguments in accordance with the Pre-Appeal Brief Conference Pilot Program.

**Status of the Claims**

Claims 1-9 and 24-27 stand finally rejected. The claims were not amended subsequent to final rejection. Claims 1-9 and 24-27 are the subject of the Notice of Appeal filed in conjunction herewith.

**SECTION 112 REJECTIONS**

Claims 1-9 and 24-27 were rejected under 35 U.S.C. § 112, 2nd paragraph, for being indefinite.

### **Arguments Supporting the Improper Section 112 Rejection of Claims 1-9 and 24-27**

**Contrary to the Examiner's suggestions, the apparatus length is described in claim 1 with a reasonable degree of clarity and precision, and therefore, is definite.** Claim 1 states, in part, "wherein by the steps of extracting and folding, the apparatus is formed having a length substantially equal to one-half of the transmitted signal wavelength." On pages 2 and 4 of the Final Office Action, the Examiner suggests that claim 1 is indefinite because the exact length of the apparatus and the transmitted signal wavelength are not recited in the claim. The Examiner maintains the rejection on page 2 of the Advisory Action by stating that "one skill[ed] in the art can not make the apparatus without knowing the length/size of the apparatus. Thus, the metes and bounds of the claim are not known. Therefore, the claims are indefinite." Although the Applicants agree on some points, the Applicants disagree with the Examiner's conclusion and the improper rejection of indefiniteness.

The Applicants agree that, in order to form an apparatus, the length of the apparatus must be known or predetermined prior to forming the apparatus. However, claim 1 does not have to recite a particular apparatus length or transmitted signal wavelength to meet the requirements of definiteness. As noted in MPEP 2173.02, the essential inquiry pertaining to the section 112, 2<sup>nd</sup> paragraph, requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and precision. The present claim provides a reasonable degree of clarity and precision by suggesting that the apparatus length is dependent on the transmitted signal wavelength. This dependence would allow one skilled in the art to form an apparatus, using the method steps recited in claim 1, by tailoring the apparatus length to a desired wavelength or wavelength range. The wavelength of the transmitted signal would be known beforehand, thus allowing the apparatus to be formed having an appropriate length. (Please refer to Applicants complete argument on pages 2-3 of the Response mailed September 9, 2007 to the Final Office Action.)

The Examiner's insistence on specifying a particular apparatus length or particular transmitted signal wavelength in the claims is unreasonably restrictive and limiting to the intended scope of the claim (i.e., to form an apparatus having a length substantially equal to one-half of a

transmitted signal wavelength). For at least the reasons set forth above, Applicants assert that this rejection is improper and request that this rejection be removed.

## **SECTION 102 REJECTIONS**

Claims 1-9, 24, and 26-27 was rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,411,261 to Lilly (hereinafter “Lilly”).

### **Arguments Supporting the Improper Section 102 Rejection of Claims 1-9 and 24-27**

**The Examiner cannot rely on drawing dimensions when the cited reference does not disclose that the drawings are drawn to scale and is silent as to the dimensions.** Claim 1 specifies an apparatus “formed having a length substantially equal to one-half of the transmitted signal wavelength.” The Examiner suggests (on pages 3-4 of the Office Action Mailed January 18, 2007) that Lilly anticipates the claimed apparatus length by disclosing that the height of the apparatus is about  $0.005\lambda$  to about  $0.05\lambda$  (in column 4, lines 45-47 of Lilly) and by illustrating that the length (x) of the apparatus is about 14 times the height (y) of the apparatus. The Examiner obtains the 14x kicker by physically measuring the length ( $x \approx 70\text{mm}$ ) and height ( $y \approx 5\text{mm}$ ) of the apparatus depicted in FIG. 10 of Lilly. The Examiner uses the x and y measurements to calculate an alleged length of about  $0.07\lambda$  to  $0.7\lambda$  for Lilly’s apparatus, and to argue that such length could be used to anticipate the presently claimed length of about  $0.5\lambda$ . The Applicants disagree and assert that the Examiner’s basis for rejection is improper.

As noted in MPEP 2125, arguments based on measurement of drawing features are of little value when the reference does not disclose that the drawings are to scale and is silent about the dimensions. Although Lilly discloses a range of possible heights (e.g., about  $0.005\lambda$  to about  $0.05\lambda$ ) for the posts (e.g., posts 106, FIGS. 1-2) included within the apparatus, Lilly is completely silent as to the length of the subsequently formed apparatus (e.g., apparatus 100, FIGS. 1-2). In addition, Lilly specifically states that the “components in the figures are not necessarily to scale” (Lilly -- col. 2, lines 54-55).

The Examiner fails to support an anticipatory rejection of claim 1 by relying on measurements of drawing features which clearly are not drawn to scale. The anticipatory rejection cannot be maintained without some teaching or suggestion within Lilly for the claimed apparatus

length. Since none exists, Applicants assert that the section 102 rejection of claims 1-9 and 24-27 is improper and request that the rejection be removed. (Please refer to Applicants complete argument on pages 4-5 of the Response mailed September 9, 2007 to the Final Office Action.)

### **SECTION 103 REJECTIONS**

Claims 1-9, 24, and 26-27 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Lilly.

#### **Arguments Supporting the Improper Section 103 Rejection of Claims 1-9 and 24-27**

**The Examiner fails to support a *prima facie* case of obviousness over Lilly.** As noted on pages 5-9 of the Response mailed September 9, 2007 to the Final Office Action, Lilly fails to provide teaching or suggestion for the claimed apparatus length. In addition, Lily lacks the necessary motivation that would enable one skilled in the art to modify the teachings of Lilly to produce an apparatus, whose length is substantially equal to one-half of a signal transmission wavelength.

On page 6 of the Office Action mailed January 18, 2007, the Examiner states that “if [Applicants] argue that Lilly does not teach the apparatus is formed having a length substantially equal to one-half of the transmitted signal wavelength then it would have been obvious... to form the apparatus [as claimed] ... [since] it has been held that where the general condition of a claim [is] disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233” (Office Action, page 6). The Examiner suggests that Lilly discloses the “general condition of the claim” by disclosing a range of “about  $0.07\lambda$  to  $0.7\lambda$  which includes the claimed one-half of the signal transmission wavelength of the present application” (Office Action, page 7). The Applicants disagree, for at least the reasons set forth below.

The Examiner suggests that one skilled in the art would be motivated to modify the apparatus of Lilly to include the claimed apparatus length because Lilly discloses the “general condition of the claim.” (Office Action, page 6). This is simply not true. Lilly does not disclose an apparatus length of “about  $0.07\lambda$  to  $0.7\lambda$ ”. As noted above, the afore-mentioned length is improperly obtained by using imprecise drawing measurements to calculate the alleged length.

These drawing measurements cannot be relied upon because (a) the drawings are not drawn to scale, and (b) Lilly is completely silent as to the actual apparatus length.

Contrary to the Examiner's suggestions, one skilled in the art would not be motivated to modify the apparatus of Lilly to include the claimed apparatus length, since Lilly fails to provide teaching or suggestion for the claimed apparatus length, and lacks the necessary motivation that would enable one skilled in the art to modify the teachings of Lilly to do so. In addition, since Lilly fails to disclose the "general condition of the claim," discovering the claimed range would involve more than routine skill in the art. Applicants, therefore, assert that the section 103 rejection of claims 1-9 and 24-27 is improper and request that the rejection be removed. (Please refer to Applicants complete argument on pages 5-9 of the Response mailed September 9, 2007 to the Final Office Action.)

As indicated above, Lilly fails to provide teaching, suggestion, or motivation for all the limitations of claim 1. In addition, the Examiner fails to properly support the anticipatory and *prima facie* case rejections of independent claim 1 and dependent claims 2-9 and 24-27.

### **CONCLUSION**

For the foregoing reasons, it is submitted that the Examiner's rejection of pending claims 1-9 and 24-27 was erroneous, and reversal of the decision is respectfully requested.

Respectfully submitted,  
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JMF